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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692
7590	10/20/2004		EXAMINER	STASHICK, ANTHONY D
Milton Wolson, Esq. Malina & Wolson Suite 501 60 East 42nd Street New York, NY 10165			ART UNIT	PAPER NUMBER
3728				
DATE MAILED: 10/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/977,463	JOHNSON, JR. <i>OK</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 June 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,5,6,8 and 9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,5,6,8 and 9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the international reference to Techboot WO 92/14372 (WO '372). WO '372 discloses all the limitations of the claim including the following: a boot (see Figure 2) having an outer layer 35 of leather (manually or mechanically) stretched over an oversized toe box 27 located beneath the outer layer; a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state; a lining 34 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 10.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 in view of Official Notice. WO '372 discloses all the limitations substantially as

claimed except for the thickness of the insulating material and the length and height of the toe box. Official Notice is taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness to insulate the boot to the hold the desired temperature. Also, it appears that the toe box of WO '372 is approximately 2 inches in height and length. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures and the proper height and length to hold the insulation layer and protector over the toes of the foot of the intended user.

5. Claims 1, 5-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,419 or Adams 4,102,062 in view of WO 92/14372.

White '419 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 8 (manually or mechanically) stretched over an oversized toe box 1 located beneath the outer layer; a layer of compressible cold insulating material 5 secured to the inside of the toe box in an uncompressed state (fastened to sole therefore not compressing uncompressed layer 5 to toe cap); a lining 6 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 9.

Adams '062 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 11 stretched over an oversized toe box 13 located beneath the outer layer; a layer of compressible cold insulating material 25 secured to the inside of the toe box in an uncompressed state (fastened to sole and not shown compressed between

liner and toe box); a lining 24 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 14.

Neither White '419 nor Adams '062 discloses the outer layer being leather or the thickness of the insulating layer or the exact length of the toe box, it appears that both White and Adams would meet this requirement as they appear to be at least two inches in both. With respect to the length and height of the toe box, WO '372 teaches that a leather exterior boot can have a toe box, insulating layer and lining located beneath the outer leather layer of a work boot to aid in insulating the user's foot from cold weather. Therefore, it would have been obvious, in view of WO '372, to make the boot used in each of White '419 or Adams '062 out of leather, as taught by WO '372, to aid in protecting the user's foot from impacts. With respect to the limitations of the thickness of the insulating layer, Official Notice is taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness necessary to insulate the boot to hold the desired temperature. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of the reference noted above the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

#### *Response to Arguments*

6. Applicant's arguments filed June 3, 2004 have been fully considered but they are not persuasive. Applicant continues the argument that the foam lining of WO '372 is compressed. This argument has bee address in previous Office action and apply here as well. With respect to

applicant's arguments directed to the stretching of the leather layer, it appears applicant is arguing more than that which is claimed. Applicant argues that the layer is stretched during the manufacturing process. Since the applicant is not claiming a method of making the product, the step of stretching during any process is not required to be met, and henceforth, has not been claimed. Applicant further argues the "oversized" portions of the claim. As previously noted, toe boxes are "oversized" to protect the user's foot, i.e. do not touch the top portion of the user's foot so as to protect the user's foot from impacts.

*Conclusion*

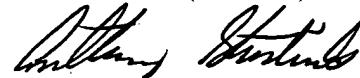
1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is (703) 308-3876. The examiner can normally be reached on Monday through Thursday from 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS